

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Sprint Docket No. 1633)

In re Application of:)
Michael T. Lundy)
Serial No.: 09/976,801) Art Unit: 3627
Filed: October 12, 2001) Examiner: Andrew J. Rudy
Confirmation No. 3983)
For: ASYNCHRONOUS USER)
AUTHORIZED ADVERTISING)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE AFTER FINAL

Dear Sir:

In response to the final office action mailed June 7, 2007, Applicant submits the following remarks. For the Examiner's convenience, a listing of the claims is provided beginning on page 2. Remarks begin on page 6.

Listing of the Claims

1. (Previously presented) A method of advertising on a subscriber terminal, the method comprising:

sending an advertising authorization request via a telecommunications network to the subscriber terminal;

receiving a reply to the advertising authorization request from the subscriber terminal, the reply providing authorization for at least one advertisement to be sent to the subscriber terminal; and

in response to the authorization, sending the at least one advertisement to the subscriber terminal when at least one triggering event occurs, wherein the at least one triggering event is selected from the group consisting of the subscriber terminal being idle and the subscriber terminal being substantially stationary.

2. (Previously presented) The method of claim 1 wherein the at least one triggering event comprises the subscriber terminal being substantially stationary.

3. (Original) The method of claim 1 wherein the advertising authorization request comprises at least one user-selectable option for authorizing the at least one advertisement to be sent to the subscriber terminal.

4. (Original) The method of claim 1, wherein the subscriber terminal comprises a display screen, the method further comprising displaying the at least one advertisement on the display screen.

5. (Original) The method of claim 1, wherein the at least one triggering event comprises the subscriber terminal being idle and substantially stationary.

6. (Previously presented) A method of advertising on a subscriber terminal, the method comprising:

 sending an advertising authorization request via a telecommunications network to the subscriber terminal;

 receiving a reply to the advertising authorization request from the subscriber terminal, the reply authorizing at least one advertisement to be sent to the subscriber terminal;

 sending the at least one advertisement to the subscriber terminal in response to receiving the reply; and

 displaying the at least one advertisement on the subscriber terminal in response to the subscriber terminal being idle and substantially stationary.

7. (Cancelled)

8. (Original) The method of claim 6 wherein the advertising authorization request comprises at least one user-selectable option for authorizing the at least one advertisement to be sent to the subscriber terminal.

9-11. (Cancelled)

12. (Previously presented) A method of advertising on a subscriber terminal, the method comprising:

retrieving a reply to an advertising authorization request from computer readable memory, the reply authorizing at least one advertisement to be sent to the subscriber terminal;

sending the at least one advertisement to the subscriber terminal in response to retrieving the reply; and

displaying the at least one advertisement on the subscriber terminal in response to the subscriber terminal being idle and substantially stationary.

13-29. (Cancelled).

30. (Previously presented) The method of claim 1 wherein sending the at least one advertisement to the subscriber terminal when at least one triggering event occurs comprises executing stored computer instructions at a processor in the telecommunications network for sending the at least one advertisement to the subscriber terminal when at least one triggering event occurs.

31. (Previously presented) The method of claim 1 wherein the function of sending the at least one advertisement to the subscriber terminal when at least one triggering event occurs is initiated by a server coupled to the telecommunications network.

32. (Previously presented) The method of claim 1, further comprising:
receiving the at least one advertisement at the subscriber terminal; and
in response to receiving the at least one advertisement at the subscriber terminal
displaying the at least one advertisement on the subscriber terminal.

33. (Cancelled)

Remarks

1. Summary of the Office Action

In the office action mailed June 7, 2007, the Examiner rejected claim 2 under 35 U.S.C. § 112 as allegedly being inconsistent with USPTO practice. Further, the Examiner rejected claims 1-6, 8, 12, and 30-32 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,442,529 (Krishan).

2. Status of the Claims

Pending are claims 1-6, 8, 12, and 30-32, of which claims 1, 6, and 12 are independent and the remainder are dependent.

3. Information Disclosure Statement

As noted in Applicant's last response, Applicant filed an information disclosure statement together with the original filing of this application, citing five references, and Applicant has not received an initialed copy of the information disclosure statement. Applicant again respectfully requests the Office to mail an initialed copy of the information disclosure statement, to confirm consideration of the art listed on the information disclosure statement, and to complete Applicant's records.

4. Response to § 112 Rejection

The Examiner rejected claim 2 as being allegedly inconsistent with USPTO practice. In particular, the Examiner asserted that claim 2 inappropriately broadens the scope of claim 1 from which it depends.

Claim 2 does not broaden the scope of claim 1. Therefore, this rejection is improper and should be withdrawn.

Claim 1 includes the Markush group reading "the at least one triggering event is selected from the group consisting of the subscriber terminal being idle and the subscriber terminal being substantially stationary." Thus, according to claim 1, the at least one triggering event is the subscriber terminal being idle *or* the subscriber terminal being substantially stationary. Claim 2 narrows the method of claim 1 by reciting that the at least one triggering event comprises the subscriber terminal being substantially stationary. This is akin to claim 1 reciting that a color is blue or yellow and claim 2 reciting that the color comprises blue. Claim 2 does not broaden claim 1.

Accordingly, Applicant submits that claim 2 is acceptable as written, and Applicant respectfully requests the Examiner to withdraw the § 112 rejection.

5. Response to § 102 Rejection

The Examiner rejected all of the claims as being allegedly anticipated by Krishan. Applicant submits that this rejection is improper and should be withdrawn, because Krishan fails to teach (expressly or inherently) all of the elements of any of the claims, as would be required to establish anticipation under M.P.E.P. § 2131.

First, Krishan fails to teach (expressly or inherently) the "authorization" functions recited in Applicant's independent claims and thus required by each of Applicant's claims. Thus, Krishan clearly fails to anticipate the claims.

Second, Krishan fails to teach the function of sending the at least one advertisement to the subscriber terminal when at least one triggering event occurs, where the triggering event comprises the subscriber terminal being substantially, as in claims 2, 5, 6, 8, 12, and 30. In this regard, contrary to the Examiner's assertion, the fact that a computer is "idle" clearly does not mean that the computer is substantially stationary. The term "idle" does not mean substantially

stationary. Indeed, it must have a different meaning, otherwise use of both terms in a claim would be redundant. It is clearly feasible for a computer to be idle and to yet be moving at the time, such as if a notebook computer is being conveyed in a vehicle while the computer is in an idle mode.

Because Krishan fails to teach the combination of elements recited in Applicant's claims, Krishan fails to anticipate the claims. Therefore, Applicant submits that the claims are allowable.

Accordingly, Applicant respectfully requests favorable reconsideration and allowance of the claims.

If the Examiner would like to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: August 6, 2007

By: /Lawrence H. Aaronson/
Lawrence H. Aaronson
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DEPOSIT ACCOUNT AUTHORIZATION

Applicant believes that no fee is required at this time. However, please charge any underpayment or credit any overpayment to Deposit Account No. 210765.

Date: August 6, 2007

By: /Lawrence H. Aaronson/
Lawrence H. Aaronson
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